

REMARKS/ARGUMENTS

In the Election/Restriction Requirement dated April 14, 2008, the Examiner delineated the following inventions as being patentably distinct.

Group I: Claims 1-3, drawn to an apheresis device; and

Group II: Claim 4, drawn to a method of using an apheresis device for providing a treatment for Alzheimer's disease.

Applicants provisionally elect with traverse Group II.

The Examiner further required the election of a single species from the following:

A. Anti-APP antibodies

B. Anti-A $\beta_{40}$  antibodies

C. Anti-A $\beta_{42}$  antibodies

D. Gelsolin

E. ApoJ

F. ApoE

G. APP-binding peptides

H. GM1

I. aptamers

Accordingly, applicants elect the species C (Anti-A $\beta_{42}$  antibodies).

Applicants note that the present Restriction Requirement was based on wrong interpretation of the term "an apheresis device" according to the present invention.

An apheresis device according to the present invention is defined on pages 10 and 11 of the English translation of the present patent application. In fact, this apheresis device includes, by its very wording, everything which is necessary to perform apheresis for a given patent including all elements that are necessary for functioning in use, i.e., with human patients. It is therefore clear that a simple affinity chromatography surface such as the one

disclosed in column 12, lines 20 to 40 of McConlogue et al. cannot be regarded as an apheresis device.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (M.P.E.P. § 803).

Moreover, when making a lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group (i.e., why there is no single inventive concept) specifically describing the unique special technical feature in each group. (M.P.E.P. § 1893.03(d)).

Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not carried the burden of providing any reasons and/or examples to support any conclusions that the claims of the restricted groups are patentably distinct, or providing any reasons and/or examples to support any conclusions that the groups lack unity of invention.

The Examiner asserts that Groups I and II do not relate to a single general inventive concept under PCT Rules 13.1 and 13.2 because they lack the same corresponding special technical feature.

The Examiner, however, has not considered that the claims in each group are considered related invention under 37 C.F.R. § 1.475(b) in which the inventions are considered to have unity of invention. Applicants submit that while PCT Rules 13.1 and 13.2 are applicable 37 C.F.R. § 1.475(b) provides in relevant part that “a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn to (3) a product, process, and the use of the product.”

Unity of invention has to be considered in first place only in relation to the independent claim. A dependent claim is one which contains all the features of another claim and is in the same category of claims as the other claims. It does not matter if a dependent claim itself contains a further invention.

Further, the M.P.E.P. § 803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct and independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office. In fact, the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Examination Report did not, the restriction is believed to be improper.

Applicants request that should the elected species be found allowable, the Examiner must expand the search to include the non-elected inventions.

Divisional applications filed thereafter claiming the non-elected inventions should not be subject to a double-patenting ground of rejection, 35 U.S.C. § 121, *In re Joyce* (Comr. Pat. 1957) 115 USPQ 412.

Application No. 10/571,469  
Reply to Election/Restriction Requirement of April 14, 2008

Applicants submit that the above identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Paul J. Killos", is written over a horizontal line.

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